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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/245,549 02/05/99 ZERVOS

A 10287/039001

EXAMINER

HM12/0130

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BOSTON MA 02110-2804

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ART UNIT

PAPER NUMBER

1656

10

DATE MAILED:

01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/245,549

Applicant(s)

Zervos

Examiner

Joyce Tung

Group Art Unit

1656

☒ Responsive to communication(s) filed on 8/29/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1656

Response to Amendment

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1656.

1. The amendment filed 8/29/2000 has been entered.
2. The rejection of claims 2-27 under 35 U.S.C. §112, second paragraph are withdrawn because of the amendment.
3. Regarding the rejection of claims 1-4, 6-12, 15-22, 25 and 27 under 35 U.S.C §103(a) over Jorgensen, the response argues that the teachings of Jorgensen do not describe generating a DNA library *in vivo* in the host cell's genome, while the present invention is directed to a method of generating a plurality of vectors containing the aforesaid inserts in a cell. However, Jorgensen suggests that a cDNA or genomic library may be prepared from the organism in question and the DNA sequence B to be amplified identified (See column 7, lines 49-51). Second, the claim language does not claim generating a plurality of vectors containing the inserts in a cell. In claim 1, 3 and 26, the language is directed to "introducing a vector molecule into each of the host cells". The response further argues that the construction of cDNA or genomic library in the teachings of Jorgensen is related to identifying the A, C and D DNA sequences. However constructing a cDNA library *in vivo* is involved with a homologous recombinant method (See the Abstract). Thus, the rejection is maintained.

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4. Claims 1-4, 6-12, 15-22, 25 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jorgensen (5,925,544).

5. Regarding the rejection of claims 3 and 13-14 under 35 U.S.C. §103(a) over Jorgensen (5,925,544) in view of Fraser et al. (4,870,023), the response argues that Fraser et al. fail to make up for the deficiencies in the Jorgensen reference. However, the method of Fraser et al. involves using a linker which ligates to the polyhedrin DNA into a cloning vector (See column 17, lines 9-14). The linker of Fraser et al. has the same function as the adapter claimed in instant claims 13-14 and based upon the discussion set forth in section 3 above. The rejection is maintained.

6. Claims 3 and 13 -14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jorgensen (5,925,544) in view of Fraser et al. (4,870,023).

7. Regarding the rejection of claims 3, 23-24 and 26 under 35 U.S.C. §103(a) over Jorgensen (5,925,544) in view of Liu et al. (5,928,868), the response argues that the combination of these references does not teach or suggest the vector/inset combination used to generate the DNA libraries *in vivo* by the claims, and second the hybrid system described by Liu et al. is an assay for small molecule screening, as opposed to a method for identifying interacting protein expressed by the *in vivo* generated libraries. However, as set forth in section 3 above, Jorgensen suggests that a cDNA or genomic library may be prepared from the organism in question and the DNA sequence B to be amplified identified (See column 7, lines 49-51). The claim language is

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directed to construct a DNA library for screening in a two hybrid system (See claims 25 and 26).

Thus, the rejection is maintained.

8. Claims 3, 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorgensen (5,925,544) in view of Liu et al. (5,928,868).

Claim Rejections - 35 U.S.C. § 112

9. Claims 2-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added language "which is capable of hybridizing to" in claims 2, 3, 11-14 and 26-27 is not supported in the specification. Thus, it constructs a new matter.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

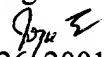
11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Margaret Parr can be reached at (703) 308-2454.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

12. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung


January 26, 2001


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600
1/29/01